

## REMARKS

The amendment does not involve new matter. The amendment made to claim 6 corrects a typographical error and does not add a limitation for any reason related to patentability.

In the Office Action Summary and on page 2 of the outstanding Office Action, the restricted and withdrawn claims are listed as 7, 11-14, 16, 17, 22-27 and 29-50. According to applicants' records, and the Office Action mailed May 29, 2002, claim 22 was not withdrawn. Further, claim 22 is rejected on page 2 in the outstanding Office Action. Thus it is believed that claim 22 is currently under consideration. Finally, claims 29-50 were cancelled in the amendment mailed May 26, 2004. It is suggested that the listing of withdrawn claims be corrected in future Office Action Summaries.

In the outstanding Office Action, claims 1-6, 8-10, 15, 18-22, 28, 51-56 and 65-68 were rejected under 35 U.S.C. § 112, second paragraph. This rejection is respectfully traversed. First, claim 53 does further limit claim 51. Even though claim 51, in its preamble, is directed to a multi-colored, sheeted chewing gum product, and the claim requires a first chewing gum and a second confectionary material, there is nothing in claim 51 that requires the second confectionary material to be a different color than the first chewing gum. On page 5 of the Office Action, it is stated, "The claim requires that the second gum be distinguishable from the second gum, and therefore it would inherently be of a different color." Even if this sentence was supposed to say that the claim requires the second confectionary material be distinguishable from the first chewing gum, there is no such requirement in claim 51. The first chewing gum itself could be multi-colored, or the second confectionary could be the same color as the first chewing gum, but a third material of a different color could be present, making the overall product multi-colored. Since claim 51 could read on products where the first chewing gum and second confectionary material are the same color, claim 53, requiring them to be different colors, does further limit claim 51.

Similarly, the product-by-process nature of claim 56 also adds further limitations not found in claim 51. The product of claim 51 could conceivably be made by embedding the rope of second confectionary in the first chewing gum before or at the

same time the first chewing gum is formed into a slab. The MPEP makes it clear that product-by-process claims may be utilized to present claims of varying scope. MPEP § 2173.05(p) (8th Ed.). In this case, claim 56 requires the first chewing gum to be formed into a slab and then the rope of second confectionary pressed into the slab. Claim 51 would cover products made by all three processes (the rope is embedded before, at the same time, or after the first chewing gum is formed into a slab), while claim 56 only covers the latter. Thus claim 56 further limits 51.

The term “generally” in claims 1, 15, 18, 20, 21 and 67, and the term “generally perpendicular” in claim 65 does not make those claims indefinite. MPEP § 2173.05(b) sets forth that words of relative terminology are acceptable if one of ordinary skill in the art would understand what is claimed in light of the specification. In claims 1, 15 18, 20 and 21, the word “generally” modifies “flat sheet,” “flat surface” and “undulating pattern.” Page 8 of the specification states that in Figure 8 the first mass of chewing gum is formed into a slab 81 with a generally flat top surface, and then gives example methods of making such a “generally flat top surface.” One of ordinary skill in the art, referring to Figure 8 and the type of operations described on page 8, would easily be able to understand what “generally flat” means. In the art of chewing gum, it is very difficult to get something exactly flat, but if someone of ordinary skill looked at slab 81 in Figure 8, they would easily recognize it as generally flat. Likewise, a person of ordinary skill in the art would be able to tell what was meant by “generally flat sheet”, “generally undulating pattern” and “generally perpendicular” as those phrases are used in the claims.

It is further noted that the same claim terms are used in U.S. Patent No. 5,538,742, which issued from a divisional application of this case. The claims in that patent have the following terms:

Claim 1: generally flat surface; generally flat sheet; (see also claims 6, 7, 12, 15, 20, 21, 24 and 29);

Claim 3: in a direction generally diagonal;

Claim 4: generally undulating pattern; (see also claim 18);

Claim 8: in a direction generally transverse to the length; (see also claim 22);

Claim 10: generally uniform size;

Claim 17: in a direction generally parallel to the length;

Claim 23: laid generally diagonally across;

Claim 31: generally uniform shape and size.

Of course the '742 patent has the same specification as the present case. Thus, the fact that the '742 patent issued with all of these claims containing the word "generally" is convincing evidence that the word "generally" used in the same way in the present claims, supported by the same specification, does not make those claims indefinite. This rejection should therefore be withdrawn.

It is noted that claims 6, 8, 10, 18-22 and 51-56 were not rejected in the outstanding Office Action over the prior art. It is believed that these claims are thus patentable once the Section 112 issues are resolved.

In the outstanding Office Action, claims 1, 2, 4, 5, 15, 65, 67 and 68 were rejected under 35 U.S.C. § 102 as anticipated by U.S. Design Patent No. 271,344 (Faust). This rejection is respectfully transversed. The Office Action takes the position that Faust discloses two color chewing gums with one embedded in the other. Claim 1, however, calls for the second mass to be embedded in the first mass so as to be visible with the first mass from the top surface of the product, but the first mass only is visible from the bottom surface. Faust does not meet at least this last limitation. In Faust, the description states that the rear perspective view and bottom view are, respectively, mirror images of the front perspective and top views shown. Hence the second color of chewing gum would be viewable from both the top and bottom surfaces, and both side surfaces. If an end surface is taken to be the top, then the "bottom" would be identical and show both colors. No matter which side is considered to be the top, the bottom will have both colors of chewing gum present.

Claim 67 has the same limitation as claim 1, that the second mass is not visible from the bottom surface of the product. Claims 2, 4, 5, 65 and 68 are dependent on claims 1 and 67, and thus also differ from Faust in the same manner. Claim 15 includes two sets of limitations, the product limitations from claim 1 and the process limitations explicitly recited in claim 15. Since claim 1 is patentable over Faust, claim 15 is also patentable over Faust for at least the same reasons.

As noted above, MPEP 2173.05 (p) indicates that product-by-process claims may be utilized to present claims of varying scope. This inherently requires that the process limitations be given patentable weight. While claim 15 has been shown to be patentable over Faust irregardless of the process limitations, it is also clear that the product of Faust would not suggest the steps of bringing at least one piece of a second mass of confectionary product into contact with a flat surface of a slab of chewing gum and pressing the slab to form a generally flat sheet with the second mass embedded in it, as required by claim 15. Hence claim 15 is not anticipated by Faust for this further reason.

In the outstanding Office Action, claims 3, 9, 28 and 66 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. Des. 271,344 (Faust) in view of U.S. Patent No. 1,855,145 (Jones) and further in view of the "Bubble Tape" and "Fruit Stripes" products referred to on page 1 of the specification. This rejection is respectfully traversed.

The Office Action takes the position that Faust discloses two layer chewing gums with one embedded in the other so that the top layer is not viewable from the bottom. Claims 3, 9, 28 and 66 are all dependent on claim 1. As noted above, claim 1 requires the second mass to be embedded in the first mass so as to be visible with the first mass from the top surface of the product, but the first mass only is visible from the bottom surface. Also as noted above, Faust does not meet this limitation. No matter which side is considered to be the top, the bottom will have both colors of chewing gum present.

Jones discloses an edible article such as a candy bar. The form of the product, and the use of two different materials to make it, is such that the eater is compelled to automatically partake of the product such that each bite has a different composition than the previous bite, thus overcoming the problem that the sense of taste becomes saturated in a small amount of time, and the last bite of a candy bar does not taste as good as the first. Figure 10 of Jones discloses a bar having a constant proportion of one material formed as a base upon which is placed a bar having a progressively changing composition.

Jones would not suggest to one of ordinary skill in the art to modify the chewing gum product of Faust to come up with the claimed invention. First, the Jones idea would not even be applicable to chewing gum, which is not swallowed bite after bite as would be the product in Jones. Since the two-color chewing gum product of Faust would normally be placed in the mouth all at once, and chewed over a period of time, there would be no advantage to putting one color of chewing gum in the form of a stripe so that each bite has a different composition. Second, the product of Faust is a chunk of gum, rather than a bar product as used in Jones. Third, chewing gum is quite different than the candy bar, cake and ices disclosed in Jones, therefore it would not have been obvious to apply the teachings of Jones to the Faust product.

The Bubble Tape and Fruit Stripes products do not make the invention of claim 1 obvious. Bubble Tape does not include multiple components, so the concept of a pattern on one side and no pattern from the bottom could not be suggested by the product. Even if someone were to combine Faust and Bubble Tape, they would produce an elongated, flattened version of the design of Faust, with both colors showing on both the top and bottom surfaces. Fruit Stripes has a stripe that shows on both sides. Thus any motivation to make a product with diagonal stripes would also be a motivation to make a product with stripes on both sides. Only Figure 10 of Jones is a product with one composition entirely making up a base and two compositions making up a top surface. However, while such a product could be readily formed using a chocolate base, it would not be obvious from even Jones of how to make such a product where the first mass is chewing gum. If one wanted to follow the teachings of Jones and make a chewing gum product, at best the product would be like the other embodiments in Jones, where both colors are apparent from both sides. It would not have been obvious to make a product like Fig. 10 of Jones using the chewing gum of Faust.

The Office Action further states that there would be motivation from Jones to modify an elongated rolled up tape product so that "a changed composition is encountered". However, the product in Jones was made of two different compositions that tasted differently. The product of Faust at most has two different colors. There is no suggestion that two different compositions be used that taste differently. Thus, even

if someone were to make the product of Faust into an elongated rolled up tape, since both compositions would taste the same, the idea behind Jones of varying the amount of one composition compared to the other in each bite would not even be applicable. Hence there would be no motivation to modify the elongated tape to have different colors present in different amounts at different longitudinal positions along the tape.

The Office Action cites *In re Levin*, 84 U.S.P.Q. 232 as supporting the rejection. However, that case is not applicable to the present claims. Levin deals with a new recipe or formula for cooking food. The present claims deal with a structure and configuration of an edible material, not the recipe or formula for making the individual first and second masses.

Since it would not have been obvious from the cited references to come up with the invention of claim 1, claims 3, 9, 29 and 66 dependent thereon are patentable over the cited references.

Since each of the rejections has been overcome, the case is in condition for allowance.

Respectfully submitted,

/Steven P. Shurtz/  
Steven P. Shurtz  
Registration No. 31,424  
Attorney for Applicants

BRINKS HOFER GILSON & LIONE  
P.O. BOX 10395  
CHICAGO, ILLINOIS 60610  
(312) 321-4200  
Direct Dial (801) 444-3933